



Dkt. 2690/68556-B/JPW/BJA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Jason D. Bannan and John E. Zabriskie
U.S. Serial No.: 09/335,581 Examiner: Ja-Na Hines
Filed: June 18, 1999 Group Art Unit: 1645
For: PEPTIDES USEFUL FOR REDUCING SYMPTOMS OF
TOXIC SHOCK SYNDROME AND SEPTIC SHOCK

1185 Ave of the Americas
New York, New York 10036
January 27, 2005

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT
IN ACCORDANCE WITH 37 C.F.R. §1.181(a)

This Petition is submitted to withdraw a holding of abandonment issued in connection with the above identified application under 37 C.F.R. §1.181(a).

Background

An Office Action was issued on November 18, 2003 in connection with the above-identified application. Applicants filed an Amendment in Response to November 18, 2003 Office Action and Petition for Three Month Extension of Time on May 18, 2004.

A further Office Action was issued on August 24, 2004 in connection with the above-identified application (see **Exhibit A**), stating that applicants' Amendment filed May 18, 2004 was not fully responsive. A response to the August 24, 2004 Office Action was due by the shortened statutory period of one (1) month from the Office Action mailing date, i.e. by September 24, 2004. However, as noted on the Summary page of the August 24, 2004 Office Action, this one month period is extendable under the

Applicants: Jason D. Bannan and John E. Zabriskie
U.S. Serial No.: 09/335,581
Filed: June 18, 1999
Page 2

provisions of 37 C.F.R §1.136(a) up to a period of six (6) months from the mailing date of the August 24, 2004 Office Action, i.e. until February 24, 2005.

However on December 15, 2004, i.e. before the 6 month period from the August 24, 2004 Office Action had expired, Examiner Ja-Na Hines, to whom the subject application is assigned, issued a Notice of Abandonment in connection with the above-identified application. The December 15, 2004 Notice (see copy annexed hereto as **Exhibit B**) states that the subject application is abandoned because of the applicants' alleged failure to timely file a proper reply to the Office Action mailed November 18, 2003 in connection with the above-identified application.

Action Taken by Applicants

(1) Telephone conferences with Examiner

After applicants received the December 15, 2004 Notice of Abandonment, Mr. Brian Amos of the undersigned's office contacted Examiner Ja-Na Hines of the United States Patent and Trademark Office. During a December 23, 2004 telephone conference, Examiner Hines agreed with Mr. Amos that the December 15, 2004 Notice of Abandonment had been issued in error. Accordingly, Mr. Amos requested that the Examiner withdraw the Notice of Abandonment. However, Examiner Hines informed Mr. Amos that she did not have the authority to withdraw the Notice of Abandonment.

Mr. Amos again contacted Examiner Hines by telephone on January 24, 2005. During the January 24, 2005 telephone conference, Mr. Amos requested that Examiner Hines issue a 'Withdrawal of Notice Previously Sent' with regard to the December 15, 2004 Notice of Abandonment. However, during a January 26, 2005 telephone conference, Examiner Hines again informed Mr. Amos that she would not withdraw the Abandonment.

Applicants: Jason D. Bannan and John E. Zabriskie
U.S. Serial No.: 09/335,581
Filed: June 18, 1999
Page 3

(2) Response to August 24, 2004 Office Action

On January 24, 2005 Applicants filed an Amendment in Response to August 24, 2004 Office Action and Petition for Four Month Extension of Time with the United States Patent and Trademark Office in connection with the above-identified application. A copy of the Amendment as filed is attached hereto as **Exhibit C**.

Action Requested

Applicants maintain that the December 15, 2004 Notice of Abandonment was erroneously issued by the Patent Office. In addition, applicants note that they timely filed a response and an appropriate petition for time in connection with the outstanding August 24, 2004 Office Action. Accordingly, applicants hereby respectfully request that the holding of Abandonment of the above-identified application be withdrawn.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

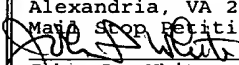
Applicants: Jason D. Bannan and John E. Zabriskie
U.S. Serial No.: 09/335,581
Filed: June 18, 1999
Page 4

No fee is deemed necessary in connection with the filing of this Petition. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Attorney for Applicant
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:	
Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	
Main Stop Petition	
	1/27/05
John P. White	Date
Registration No. 28,678	

4490 | 6455-B
 FEB 01 2005
 Office Action Summary
 PATENT & TRADEMARK OFFICE

JPW

Application No. 09/335,581	Applicant(s) BANNAN ET AL 29
Examiner Ja-Na Hines	Art Unit 1645

COPY

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

AUG 27 2004

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50 and 56-63 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☐ Claim(s) _____ is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

1 mo. 9-24-2004
 2 mo. 10-24-2004
 3 mo. 11-24-2004
 4 mo. 12-24-2004
 5 mo. 1-24-2005
 6 mo. 2-24-2005

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s) _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Inf |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant: Jason D. Bannan et al.
 U.S. Serial No.: 09/335,581
 Filed: June 18, 1999
 Exhibit A

DETAILED ACTION

Non-responsive Amendment

1. The reply filed on May 21, 2004 is not fully responsive to the prior Office action because of the following omission(s) or matter(s): Currently amended claim 50 and newly submitted claims 56-63 are now directed to inventions that are independent or distinct from the invention originally claimed. The currently amended and new claims are now drawn to a non-toxic purified peptide consisting of consecutive amino acids having an amino acid sequence set forth in SEQ ID NO:28. Previously, the claims were drawn to a peptide consisting of SEQ ID NO:34.

Applicants are not entitled to change the invention during prosecution. Applicants are requested to reinstate claims based upon the original invention. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment.


EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ja-Na Hines whose telephone number is 571-272-0859. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

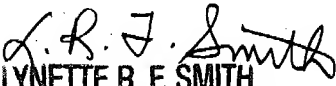
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on 571-272-0864. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1645

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ja-Na Hines 

August 16, 2004


LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

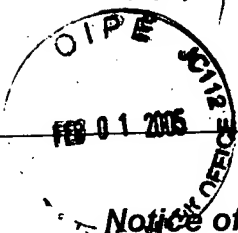
APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/335,581	06/18/1999	JASON D. BANNAN	2016-4010US2	6638
7590 08/24/2004				
JOHN P. WHITE COOPER & DUNHAM LLP 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036				
EXAMINER HINES, JANA A				
ART UNIT		PAPER NUMBER		
1645				

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

2690 / 68556-D

JPW



COPY

Notice of Abandonment	Application No.	Applicant(s)	
	09/335,581	BANNAN ET AL.29	
	Examiner	Art Unit	
	Ja-Na Hines	1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

Petition to Revive: 2/15/05 rxl

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 18 November 2003.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☒ A reply was received on 21 May 2004 but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below). DEC 21 2004
 - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

Applicant has failed to respond to any of the non-responsive notices. Therefore, according to the notices sent out from the office, this case is now abandoned.


MARK NAVARRO
PRIMARY EXAMINER

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment u minimize any negative effects on patent term.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/335,581	06/18/1999	JASON D. BANNAN	2016-4010US2	6638

7590 12/15/2004

JOHN P. WHITE
COOPER & DUNHAM LLP
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

HINES, JANA A

ART UNIT PAPER NUMBER

1645

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



Docket No. 2690/68556-B/JPW/BJA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

COPY

Applicant(s): Jason D. Bannan and John E. Zabriskie
Serial No.: 09/335,581 Examiner: Ja-Na Hines
Filed: June 18, 1999 Group Art Unit: 1645
For: Peptides Useful for Reducing Symptoms of Toxic Shock
Syndrome and Septic Shock

Mail Stop Amendment
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Date: January 24, 2005

Sir:

Transmitted herewith is an amendment to the above-identified application.

☒ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 has been previously established.

☐ A verified statement to establish small entity status under 37 C.F.R. §1.9 and §1.27 is enclosed.

☐ No additional fee is required.

The filing fee is calculated as follows:

	Number after Amend-ment	Highest Number Previously Paid For ¹	Number of Extra Claims Presented	RATE			FEE	
				Small Entity	Other Entity		Small Entity	Other Entity
Total Claims	1 -	* 20 =	*** 0 X	\$25	\$50	=	0	
Indepen-dent Claims	1 -	** 3 =	*** 0 X	\$100	\$200	=	0	
Multiple Dependent Claim(s) Presented For First Time <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No				\$180	\$360	=	0	
				TOTAL ADDITIONAL FEE			\$ 0	

¹ The "HIGHEST NUMBER PREVIOUSLY PAID FOR" (Total or Independent) is the highest of the "NUMBER AFTER AMENDMENT" in any prior amendment or the number of claims originally filed.

* If the "HIGHEST NUMBER PREVIOUSLY PAID FOR" is less than 20, write "20" in this space.

** If the "HIGHEST NUMBER PREVIOUSLY PAID FOR" is less than 3, write "3" in this space.

*** If the difference between the "NUMBER AFTER AMENDMENT" and the "HIGHEST NUMBER PREVIOUSLY PAID FOR" is less than "0", write "0".

Applicant: Jason D. Bannan et al.
U.S. Serial No.: 09/335,581
Filed: June 18, 1999
Exhibit C



Dkt. 2690/68556-B/JPW/BJA

COPY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Jason D. Bannan and John E. Zabriskie
U.S. Serial No.: 09/335,581 Examiner: Ja-Na Hines
Filed: June 18, 1999 Group Art Unit: 1645
For: PEPTIDES USEFUL FOR REDUCING SYMPTOMS OF
TOXIC SHOCK SYNDROME AND SEPTIC SHOCK

1185 Ave of the Americas
New York, New York 10036
January 24, 2004

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

AMENDMENT IN RESPONSE TO AUGUST 24, 2004 OFFICE ACTION AND
PETITION FOR FOUR MONTH EXTENSION OF TIME

This Amendment is submitted in response to an August 24, 2004 Office Action issued by the U.S. Patent and Trademark Office in connection with the above-identified application. A response to the August 24, 2004 Office Action was due September 24, 2004. Applicants hereby petition for a four month extension of time to respond. The fee for a four month extension of time for a small entity is SEVEN HUNDRED AND NINETY FIVE DOLLARS (\$795.00). Applicants enclose a check for FIVE HUNDRED TEN DOLLARS (\$510.00) and authorize charging the amount of TWO HUNDRED EIGHTY FIVE DOLLARS (\$285.00) fee to Deposit Account No. 03-3125. Accordingly, the total required fee of \$795.00 (i.e. \$510.00 check plus \$285.00 charged to deposit account) is being paid. Applicants have previously established small entity status. With a four month extension of time, a response is now due January 24, 2004. Accordingly, this Amendment is being timely filed.

Please amend the subject application as follows:

Applicants: Jason D. Bannan and John E. Zabriskie
U.S. Serial No.: 09/335,581
Filed: June 18, 1999
Page 2

Listing of Claims:

1-49. (Canceled)

50. (Currently Amended) A non-toxic, purified peptide consisting of consecutive amino acids having an amino acid sequence set forth in $X_{25}X_{26}YGGX_1TX_2X_3X_4X_5N$ ~~(SEQ ID NO:28)~~ wherein X_1 is V, X_2 is L, X_3 is H, X_4 is E, X_5 is G, X_{25} is C, and X_{26} is M (SEQ ID NO:34) ~~wherein X_1 is I or V, X_2 is L, E, K, P, or N, X_3 is H, A, or no amino acid, X_4 is D, N, E, Q, or H, X_5 is N, G, S, or R, X_{25} is C, Y, or no amino acid, and X_{26} is M, T, L, I, or no amino acid.~~

51-63. (Canceled)

Applicants: Jason D. Bannan and John E. Zabriskie
U.S. Serial No.: 09/335,581
Filed: June 18, 1999
Page 3

Remarks

Claims 50 and 56-63 are pending and under examination in the subject application. By this Amendment, applicants have hereinabove amended claim 50 and canceled claims 56-63 without prejudice to applicants' right to pursue the subject matter of these claims in a future application. Applicants maintain that the amendments to claim 50 raise no issue of new matter and are fully supported by the specification as filed. Support for the amendments to claim 50 may be found, *inter alia*, in the specification, as originally filed, on page 17, line 28 to page 18, line 11; page 24, lines 18-20; page 10, lines 22-23; page 21, lines 20-29, and originally filed claim 3. Accordingly, applicants respectfully request entry of this Amendment. Upon entry of this Amendment, claim 50 will be pending and under examination.

Non-Responsive Amendment

In the August 24, 2004 Office Action, the Examiner alleged that applicants' response filed on May 21, 2004 is not fully responsive to the prior Office Action because amended claim 50 and new claims 56-63 are directed to inventions that are distinct from the invention originally claimed. The Examiner further stated that the amended and new claims are drawn to a peptide having the amino acid sequence set forth in SEQ ID NO:28, and that previously the claims were drawn to a peptide having the amino acid sequence set forth in SEQ ID NO:34.

In response, and in order to expedite prosecution, but without conceding the correctness of the Examiner's position, applicants have hereinabove amended claim 50. Applicants note that claim 50

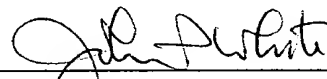
Applicants: Jason D. Bannan and John E. Zabriskie
U.S. Serial No.: 09/335,581
Filed: June 18, 1999
Page 4

is directed to SEQ ID NO:34. Accordingly, applicants maintain that amended claim 50 is not directed to an invention "distinct from the invention originally claimed".

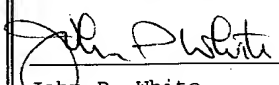
If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the \$795.00 fee for a four month extension of time, (being paid by the enclosed \$510.00 check and the authorization to charge to the deposit account no. 03-3125 a fee of \$285.00) is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such additional fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Attorney for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450	
	1/24/05
John P. White	Date
Registration No. 28,678	